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WALKER DIGITAL FIVE HIGH RIDGE PARK STAMFORD, CT 06905			CARLSON, JEFFREY D	
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GROUP 3600

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 24

Application Number: 09/260,437

Filing Date: March 02, 1999

Appellant(s): WALKER ET AL.

Dean Alderucci
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 1/20/04.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims between groups I (1-4, 10-21, 23-30, 32-34, 70-72), group II (5-9), group III (22), and group IV (31) do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) *ClaimsAppealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

5,250,789	Johnsen	10-1993
6,024,288	Gottlich	2-2000
5,759,101	Von Kohorn	6-1998
5,467,269	Flaten	11-1995

Horton, Liz, "Holiday gift subs up, some due to novel promotions," Folio: The Magazine for Magazine Management, vol. 21, no. 2, pg. 39.

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-4, 10-34 and 70-72 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnsen (US5250789) in view of Gottlich et al (US6024288) and Folio 2/1/92 (Holiday gift subs up, some due to novel promotions). Johnsen teaches in column 9 lines 25-33, the concept of optically scanning a product at a retailer, searching a database for any rebates that match the product, displaying a message offering a rebate and printing a rebate form. Gottlich et al states that it is known to issue a coupon/discount incentive at the checkout for a related item based upon an identified item currently being purchased. Gottlich et al provides examples of related products that would benefit from such incentive systems. Folio 2/1/92 teaches the idea of selling a product at a retail store, the product being a magazine subscription. It would have been obvious to have offered and created any type of coupon/rebate/savings incentive, including a rebate or discount for Folio 2/1/92's subscription purchase when a related "item" is scanned at the point of sale. This would enable subscription incentives to be

offered and targeted to purchases of related products as well as provide incentives for consumers to purchase subscriptions which are not particularly selling well. It is taken to be inherent, if not obvious in Johnsen to have stored the necessary rebate information in the POS accessible database so that a customer could be informed of the corresponding subscription rebate when the related item is scanned and the associated rebate is communicated/offered to the customer. The printed rebate form would inherently include printed information about the rebate, including rebate identification so that it could be properly processed as is well known. Such printing or "coding"/"code" reads on the code of applicant's claims. Johnsen teaches printing such "code(s)", which inherently includes outputting a signal representing the code in order to print the rebate information/code. The combination teaches outputting an offer for a discount in exchange for establishing a subscription when a related product is purchased. The coding/printing is specific to the particular rebate in the database and is selected from the totality of coding/printing associated with all of the stored rebate offers. It would have been obvious to one of ordinary skill at the time of the invention that the printing/coding of the rebate offer would include valid dates, productID, product description as well as contact info such as rebate provider, telephone help line, address, phone number, etc as is known with rebates so that the customer can identify the rebate offer and parameters. The printed rebate form is inherently a machine readable message (specific to the item), however, it would have been obvious to one of ordinary skill at the time of the invention to have provided the necessary info such as valid dates, productID, product description, etc as is known with rebates as bar-coded data so as to

more efficiently enable processing. Official Notice is taken that it is well known to pay for items at a POS by swiping a credit card. It would have been obvious to one of ordinary skill at the time of the invention to have swiped a credit card for ease of payment. Such a credit card transaction inherently includes receiving an accountID. Claim 23 is met at least by the database search for a valid rebate (offer rebate if matching rebate is found). Regarding claim 31, the subscription package ultimately includes an issue of the magazine. Further, it would have been obvious to one of ordinary skill at the time of the invention to have offered and/or bundled the subscription package with the current issue of the magazine to encourage impulse purchases for those who pick up and leaf through the current issue. Gottlich teaches examples of related items triggering incentive offers for related products. A relationship between a single issue of a periodical available for retail purchase and a subscription of a periodical available for retail purchase is clear and would have been obvious to tie together in a related offer scenario as set forth by Gottlich. Regarding claim 33 and 34, it would have been obvious to one of ordinary skill at the time of the invention to have provided text describing the magazine offer and/or numeric dates and/or numeric pricing with the printing/coding on the rebate form printout.

Claims 5-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnsen in view of Gottlich et al and Folio 2/1/92 as applied to claim 1 above, and further in view of Von Kohorn (US5759101). Von Kohorn teaches the use of codes printed on coupons including dates, terms of redemption, product and a validation code to verify authenticity. It would have been obvious to one of ordinary skill at the time of

the invention to have provided these and/or other related codes/printing with the rebate form of Johnsen to convey the details of the offer and to enable authenticity and prevent fraud. It would have been obvious to one of ordinary skill at the time of the invention to have created authenticity coding by any known means including random code generation or encryption of code attributes, so as to prevent fraud or reverse-engineering of coupons and enable authenticity as desired by Von Kohorn.

Claims 5-9 are alternatively rejected under 35 U.S.C. 103(a) as being unpatentable over Johnsen in view of Gottlich et al and Folio 2/1/92 as applied to claim 1 above, and further in view of Flaten (US5467269). Flaten teaches in column 2 lines 46-56 the use of codes printed on coupons or rebate forms such as productID, storeID, manufacturerID, retailerID, etc to supply valuable marketing and routing information to the system. It would have been obvious to one of ordinary skill at the time of the invention to have provided these and/or other related codes/printing with the rebate form of Johnsen so that the marketing data can be captured.

(11) Response to Argument

Applicant argues that there are several advantages to the instant invention not recognized by the applied art. None of these advantages are represented in the claims as required limitations. Nonetheless, applicant's listed advantages can also be achieved with the proposed combination (customer gets a lower price, publisher sells a subscription to a customer not initially intending to buy a subscription, periodical offered is related/tied to the item providing a more attractive offer). Likewise, the applied art need not address the same problems stated by applicant.

Applicant argues that there is no teaching to offer a rebate in exchange for establishing a subscription. As stated above, Gottlich et al states that it is known to issue a coupon/discount incentive at the checkout for a related item based upon the item currently being purchased. Folio 2/1/92 teaches the idea of selling a product at a retail store, the product being a magazine subscription. It would have been obvious to have offered and created any type of coupon/rebate/savings incentive, including a rebate or discount for Folio 2/1/92's subscription purchase when a related "item" is scanned at the point of sale.

Applicant argues that Gottlich's coupon provides a *future* discount. Redemption timing for the incentive/rebate is not present in claim 1.

Applicant argues that Folio's methods may be less than successful that traditional subscription sales. This argument is superfluous.

Applicant argues that the applied references are disparate systems outside applicant's field of endeavor. Examiner disagrees. Two teach rebates/incentives/coupons for retail products. The third teaches that subscriptions can be sold as retail items. All three references need not teach subscriptions. Applicant appears to be convinced that the inventive features stem from the fact that subscriptions are being sold in retail environments. Folio teaches that subscriptions can be sold as retail items. One of ordinary skill would clearly be motivated to provide rebates/incentives with retailer-offered subscriptions for the same reasons that countless other retail products/services are offered via incentives.

Applicant argues that motivation must be provided by the references and the motivations given by the examiner are mere statements of benefits. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found **either** in the references themselves **or in the knowledge generally available to one of ordinary skill in the art.** See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the examiner-provided benefits are taken to be within the knowledge of one of ordinary skill and these benefits surely provide motivation.

Applicant argues that the examiner must define the level of ordinary skill. Examiner disagrees with this requirement, although care has been made that the provided combinations, motivations and interpretations are reasonably within the knowledge of one having "ordinary skill."

Applicant mentions the examiner's taking of Official Notice, yet these statements are not taken to successfully provide a seasonable challenge. Further, claim 1 of group I (having claims that stand or fall together) is not rejected based on the taking of official notice.

Applicant argues that the authenticity features of Von Kohorn are not required for the freely distributed coupons of Johnsen. Applicant's claim 5 in this group which stand or fall together requires only selection of code from a plurality of codes. The proposed

combination provides retrieval of an identified incentive (one that is associated with the item) from the pool a plural stored incentives (for all items).

Applicant argues that the examiner's combination fails to meet claim 22. The proposed rejection clearly sets forth a rebate offer related to an item; the tying of purchased items to related offers is taught by Gottlich.

Applicant argues that claim 31 is not addressed. Examiner provided a rejection of claim 31 as detailed above.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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Primary Examiner
Art Unit 3622



jdc
April 1, 2004

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